

REMARKS

Claims 1-40 are currently pending, wherein Applicants propose to amend claim 1 and cancel claims 9 and 15. Favorable reconsideration is respectfully requested in view of the remarks presented herein below.

In paragraph 3 of the final Office action ("Action"), the Examiner rejects claims 9 and 15 under 35 U.S.C. 112, second paragraph as being indefinite. Claims 9 and 15 have been canceled, rendering this rejection moot.

In paragraph 5 of the Action, the Examiner rejects claims 1-4, 6-11, 13-17, 19-22, 25, 29-31 and 35-40 under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application Publication No. EP 0 856 972 A2 to Shiota et al. ("Shiota"), in view of U.S. Patent No. 7,016,868 B1 to McIntyre et al. ("McIntyre"), further in view of U.S. Patent No. 6,535,294 B1 to Arledge, Jr. et al. ("Arledge"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-4, 6-11, 13-17, 19-22, 25, 29-31 and 35-40 are not rendered unpatentable over the combination of Shiota, McIntyre, and Arledge because the combination fails to disclose each and every claimed element. More specifically, the combination fails to disclose a computer-readable medium storing digital image data, server-connection address information, and print-order acceptor information as claimed.

Independent claim 1 defines an image print order system using a network. The system includes, *inter alia* an order receiving server which is connected to said network and a terminal unit connectable to said network, to which a computer-readable medium can be mounted. Further more, when a computer readable medium storing digital image data, server-connection address information, and print-order acceptor information which designates an acceptor as a print-order destination, is mounted to said terminal unit, the terminal unit is connected to said order receiving server based on said server-connection address information so as to transmit said

designated print-order acceptor information and at least a part of said digital image data at the same time to said order receiving server.

In rejecting claim 1, the Examiner asserts that Shiota discloses a computer-readable medium storing image data, server-connection address information, and print-order acceptor information but does not disclose that the computer-readable medium is mountable to the terminal as claimed. Accordingly, the Examiner relies on McIntyre to teach a mountable computer-readable medium storing data and connecting to a server when the medium is mounted. However, nowhere in Shiota or McIntyre is there any disclosure of the mountable computer-readable medium storing print-order acceptor information that designates an acceptor as a print-order destination as claimed.

As pointed out by the Examiner on page 4 of the Action, Shiota discloses “when the customer wants to receive the print over the counter, the order information data showing the laboratory at which the print is received is referred to, and the laboratory is selected as the laboratory to output the print.” (See column 11, lines 10-14 of Shiota). Also, Shiota discloses that “the customer 1 can request a printing service ... through generation of order information in a predetermined format and transmission of the information via electronic mail.” (See column 10, lines 5-13 of Shiota). That is, Shiota merely discloses generating the order information indicating a laboratory at which a user receives a print. Shiota fails to teach a computer readable medium that stores print-order acceptor information which designates an acceptor as a print-order destination.

McIntyre discloses that “the CD is provided with a computer software program which when loaded on a computer will allow a user to communicate to a network photoservice provider 34.” (See column 6, lines 25-30 of McIntyre). However, McIntyre fails to teach a computer-readable medium that stores print-order acceptor information which designates an acceptor as a print-order destination.

Furthermore, although Arledge discloses storing information relating to franchised stores in an information database 220, the information including store number, city, state, address, and web-site address, nowhere in Arledge is there any disclosure or suggestion of this information being stored in a mounted computer-readable medium as claimed. To the contrary, Arledge

specifically discloses that the store information is stored in an information database 220 which is accessed by the server computer not mounted to a terminal as claimed.

Since Shiota, McIntyre, and Arledge each fails to disclose or suggest a mountable computer-readable medium as recited in claim 1, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Shiota, McIntyre, and Arledge, the combination would still fail to render claim 1 unpatentable because the combination fails to disclose each and every claimed element.

Dependent claim 3, in addition to the elements of claims 1 and 2 from which it depends, further recites that the print-order acceptor information is recorded on the mountable computer-readable medium as URL data for specifying a WWW page created for each acceptor. In rejecting claim 3, the Examiner asserts that the combination of Shiota, McIntyre, and Arledge discloses storing print-order acceptor information as URL data in as much as Arledge discloses storing information including a website address of franchised stores in a database. However, as discussed above with respect to claim 1, Arledge fails to disclose or suggest that the franchised store information is stored on a mountable computer-readable medium as claimed. Accordingly, claim 3 is patentable over the combination of Shiota, McIntyre, and Arledge because the combination fails to disclose each and every claimed element.

Independent claims 10, 16, 20, and 29, like claim 1, each recite, *inter alia*, a mountable computer-readable medium having stored therein image data, connection address information, and print-order acceptor information that designates an acceptor as a print-order destination. Accordingly, claims 10, 16, 20 and 29 are patentable over the combination of Shiota, McIntyre, and Arledge for at least those reasons presented above with respect to claim 1. Claims 2, 4, 6-9, 11, 13-15, 17, 19, 21, 22, 25, 30-31, and 35-40 variously depend from independent claims 1, 10, 16, 20, and 29. Therefore, claims 2, 4, 6-9, 11, 13-15, 17, 19, 21, 22, 25, 30-31, and 35-40 are patentable over the combination of Shiota, McIntyre, and Arledge for at least those reasons presented above with respect to claim 1.

For at least those reasons presented above, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-4, 6-11, 13-17, 19-22, 25, 29-31, and 35-40 under 35 U.S.C. § 103.

In paragraphs 6 and 7 of the Action, the Examiner rejects claims 5-9, 23, 24, and 32 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Shiota, McIntyre, and Arledge, further in view of U.S. Patent No. 6,742,023 to Fanning et al. ("Fanning"). Applicants respectfully traverse this rejection.

Claims 5-9, 23, 24, and 32 variously depend from claims 1 and 20. Therefore, claims 5-9, 23, 24, and 32 are patentable over the combination of Shiota, McIntyre, and Arledge for at least those reasons presented above with respect to claims 1 and 20.

Fanning discloses a use-sensitive system for distribution of data files between users in a networked community of users. However, Fanning fails to overcome the deficiencies of Shiota, McIntyre, and Arledge. Since Shiota, McIntyre, Arledge, and Fanning each fails to disclose or suggest a mountable computer-readable medium as recited in claims 5-9, 23, 24, and 32, the combination of these four references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Shiota, McIntyre, Arledge, and Fanning, the combination would still fail to render claims 5-9, 23, 24, and 32 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claims 5-9, 23, 24, and 32 is respectfully requested.

In paragraph 8 of the Action, the Examiner rejects claims 26-28, 33 and 34 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Shiota, McIntyre, and Arledge, further in view of U.S. Patent No. 6,611,812 to Hurtado et al. ("Hurtado"). Applicants respectfully traverse this rejection.

Claims 26-28, 33 and 34 variously depend from claims 20 and 29. Therefore, claims 26-28, 33 and 34 are patentable over the combination of Shiota, McIntyre, and Arledge for at least those reasons presented above with respect to claims 20 and 29.

Hurtado discloses a method of secure electronic content distribution on CDS and DVDs. However, Hurtado fails to overcome the deficiencies of Shiota, McIntyre, and Arledge. Since Shiota, McIntyre, Arledge, and Hurtado each fail to disclose or suggest a mountable computer-readable medium as recited in claims 26-28, 33 and 34, the combination of these four references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Shiota, McIntyre, Arledge, and Hurtado, the combination would still fail

to render claims 26-28, 33 and 34 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claims 26-28, 33 and 34 is respectfully requested.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny L. Caudle Reg. No. 46,607 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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